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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,896	10/30/2003	David R. Oran	112025-0424C1	9197
24267	7590	01/13/2005	EXAMINER	
CESARI AND MCKENNA, LLP 88 BLACK FALCON AVENUE BOSTON, MA 02210			BEHNCKE, CHRISTINE M	
			ART UNIT	PAPER NUMBER
			3661	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,896

Applicant(s)

ORAN ET AL.

Examiner

Christine M. Behncke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-25, 28-30, 35, 36, 39 and 40 is/are rejected.
- 7) ☒ Claim(s) 26, 27, 31-34, 37 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/30/03, 10/30/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to Application Serial No. 10/697896 filed on October 30, 2003, wherein claims 21-40 were presented for examination.

Specification

2. The disclosure is objected to because of the following informalities:

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

3. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior non-provisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number. Appropriate correction is required.

Drawings

4. The drawings are objected to because Figure 6, reference elements 606 and 608 do not correspond with the detailed description of the specification, page 13 lines 13-14. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version

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of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency.

Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 21 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,665,611 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of claim 21 is broader and fully encompasses and reads on the invention defined in claim 1 of the patent. Specifically the "one or more network messages" of the application encompasses "a network message" of the patent.

7. Claim 22 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,665,611 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of claim 22 in combination with claim 21 is broader and fully encompasses and reads on the invention defined in claim 2 combined with claim 1 of the patent. Specifically, it is inherent that a GPS receiver for determining physical coordinates would communicate with a plurality of GPS satellites.

8. Claim 23 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,665,611 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of claim 23 in combination with claims 21 and 22 is broader and fully encompasses and reads on the invention defined in claim 3 combined with claims 1 and 2 of the patent.

9. Claim 24 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,665,611 B1. Although the conflicting claims are not identical, they are not patentably distinct from

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each other because the broader claimed subject matter "radio signals" encompasses the more narrowly defined "radio beacon signals" of the patent.

10. Claim 25 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,665,611 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the broader claimed subject matter encompasses the more narrowly defined subject matter of the preceding claims of the patent.

11. Claim 28 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10, 11, 12 and 18 of U.S. Patent No. 6,665,611 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of claim 28 is broader and fully encompasses and reads on the method defined in claims 10-12 and 18 of the patent.

12. Claim 35 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 11 of U.S. Patent No. 6,665,611 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the broader claimed subject matter encompasses the more narrowly defined subject matter of the preceding claims of the patent. Specifically, it would be obvious to implement/teach the method of claims 10 and 11 of the patent with the system means disclosed in the application claim 35.

13. Claim 36 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18 and 19 of U.S. Patent No.

6,665,611 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the broader claimed subject matter encompasses the more narrowly defined subject matter of the preceding claims of the patent. Specifically, it would be obvious to implement/teach the method of claims 18 and 19 of the patent with the system generating means disclosed in the application claim 36.

14. Claims 39 and 40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,665,611 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the broader claimed subject matter encompasses the more narrowly defined subject matter of the preceding claims of the patent. Specifically, it would be obvious to implement/teach the method of claim 12 of the patent with the system means disclosed in the application claims 39 and 40.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. Claims 29 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang, US Patent Application Publication 2002/0160745.

17. (Claim 30) Wang discloses a storage medium containing program instructions executable by a processing element for associating physical location information with one or more network messages originating from a source entity ([0006] and [0065]), the one or more network messages being directed to a destination entity ([0068]), the program instructions comprising program instructions for: receiving physical coordinates of the location of the source entity ([0006] and [0065]); storing the physical coordinates received for the source entity ([0041]); receiving the one or more network messages originating from the source entity ([0065]); forwarding the one or more network messages toward the destination entity ([0065]); and sending the physical coordinates received for the source entity to the destination entity ([0065]).

18. (Claim 30) Wang further discloses wherein the program instructions for sending comprise program instructions for appending the physical coordinates to at least one of the one or more network messages originating from the source entity ([0065]-[0068]).

Allowable Subject Matter

19. Claims 26, 27, 31-34, 37, 38 are objected to as being dependent upon a rejected base claim and are at present considered to overcome the prior art of record if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine M. Behncke whose telephone number is (703)

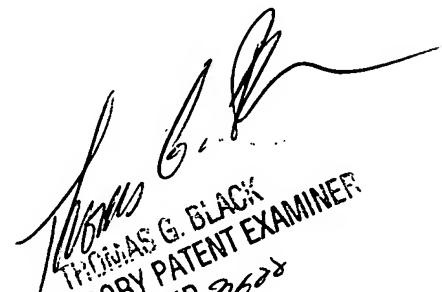
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305-0589. The examiner can normally be reached on Monday - Friday 8:30 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G. Black can be reached on (703) 305-8233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

01/07/05


THOMAS G. BLACK
SUPERVISORY PATENT EXAMINER
GROUP 3628